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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,258	12/01/2003	Jeffrey M. Leiden	104914.231	2218
388	7590	11/18/2004	EXAMINER	
FULBRIGHT & JAWORSKI MARKET SQUARE 801 PENNSLYVANIA, N.W. WASHINGTON, DC 200042604			FALK, ANNE MARIE	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 11/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,258

Applicant(s)

LEIDEN, JEFFREY M.

Examiner

Anne-Marie Falk, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

The amendment filed December 1, 2003 has not been entered for the reasons detailed below.

Reissue Applications

Surrender of the Original Patent

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Declaration Defective

The reissue declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

In the reissue application declaration filed December 1, 2003, Applicant states that the original patent is believed to be wholly or partly inoperative or invalid by reason of a defective specification. Applicant further states that the error upon which the reissue is based is "failure to adequately claim priority based on an international application."

As issued, the first sentence of the patent states:

"This application is a continuation in part of U.S. Provisional Patent Application Ser. No. 60/024,511, filed Aug. 23, 1996, the disclosure of which is incorporated herein by reference."

Applicant seeks to amend the benefit claim by way of a Preliminary Amendment to read:

--This application is a national stage application of International Application No. PCT/US97/14764, filed August 22, 1997, which claims the benefit of provisional application U.S. Ser. No. 60/024,511, filed August 23, 1996, the disclosure of which are incorporated herein by reference.--

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By specifying a relationship (i.e., continuation in part) to the prior provisional application, the national stage application claimed benefit under 35 U.S.C. § 120. MPEP § 201.11, subsection B indicates that when a relationship between a prior provisional and subsequent nonprovisional application is stated in making the priority claim, such is construed as a claim for benefit under 35 U.S.C. § 120 of the prior provisional and not a section 119(e) claim for benefit.

See also the Official Gazette Notice of 18 March 2003, 1268 OG 89, entitled "Claiming the Benefit of a Prior-Filed Application under 35 U.S.C. §§ 119(e), 120, 121, and 365(c)", particularly Part II.

Apparently, although not currently present in the official file, a decision on the petition of December 1, 2003 was mailed to Applicant on June 29, 2004. The petition was dismissed. Applicants were advised that a petition under 37 CFR 1.78 was improper since the application had already passed to issue. A request pursuant to 37 CFR 1.78 for an unintentionally delayed claim for priority must be made during the pendency of the application.

The proposed changes to the priority claim are not a proper error for reissue because they do not represent a defect in the issued patent. While Applicants may regret claiming priority to their provisional application under 35 U.S.C. 120 rather than under 35 U.S.C. 119(e), it is not a defect and therefore cannot be corrected via a reissue application.

It is further noted that 35 U.S.C. § 119(e)(1) requires that a claim of priority under § 119(e) must be filed "during the pendency of the application." Thus, since the application issued as a patent on September 2, 2003, Applicant is now barred from filing a priority claim under § 119(e).

By statute a reissue patent only covers "the unexpired term of the original patent" (35 U.S.C. 251). Thus, since the term of the original patent was measured from the filing date of the provisional application (see 35 U.S.C. § 154(a)(2)), even if a reissue patent were granted it will not operate to extend the term of the original patent.

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With regard to Applicant's statement in their declaration that the error upon which the reissue is based is "failure to adequately claim priority based on an international application," it is noted that Applicant is barred from claiming priority to PCT/US97/14764 because it is not a **prior** application. Both the international application and the national stage application have the **same filing date**. The application upon which the patent issued is the **national stage** of an application filed under 35 U.S.C. 371. See MPEP § 1893.03(c), subsection entitled "BENEFIT CLAIM UNDER 35 U.S.C. 119(e), OR 120 AND 365(c)", paragraph under "Note:". Furthermore, the proposed preliminary amendment to the first sentence of the specification does not have the effect of claiming **priority** to the international application since it is in fact noting its status as a **371 application**.

It is further noted that there is no requirement to include reference to the application's 371 status in the first sentence of the specification. Thus, the absence of such a statement does **not** represent a defect.

Errors that are merely typographical in nature may not, by themselves, sustain or support a reissue. The typographical errors noted in Claims 1 and 11 may be corrected by a request filed pursuant to 37 CFR 1.322, accompanied by evidence to show that the error is attributable solely to the Office, to obtain expedited issuance of a Certificate of Correction. See MPEP § 1480.01.

It is further noted that the Office failed to print the § 371 data on the front page of the patent. Applicants may request a Certificate of Correction to properly indicate the § 371 data.

Claim Rejections - 35 USC § 251

Claims 1-24 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

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Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne-Marie Falk whose telephone number is (571) 272-0728. The examiner can normally be reached Monday through Friday from 10:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (571) 272-0804. The central official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Anne-Marie Falk, Ph.D.

Anne-Marie Falk
ANNE-MARIE FALK, PH.D
PRIMARY EXAMINER